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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/395,805	09/14/1999	HIDEYUKI KINOSHITA	PM-264009	6497

22242 7590 11/06/2002

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120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1774

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DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-27

<b>Office Action Summary</b>	<b>Application No.</b> 09/395,805	<b>Applicant(s)</b> KINOSHITA ET AL.	
	<b>Examiner</b> Betelhem Shewareged	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Applicant's Request for Continued Examination has been fully considered. Claim 1 is amended, claims 9 and 10 are added and claims 1 and 4-10 are pending.
2. Claims 1 and 4-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawatsu et al. (US 6,025,286).

A heat-sensitive stencil sheet comprises a fibrous support of polyester fibers, and a polyester film laminated on the fibrous support. Adhesive may be used for laminating the fibrous support and the polyester film (abstract, background art and claim 1). With respect to tensile strength value, T-H value, and KES bending rigidity value B it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Kawatsu reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Applicant is arguing that the record lacks citation to any specific passage in the Kawatsu reference that demonstrates that the allegedly inherent characteristic, residual torque as claimed, inevitably, necessarily, inherently is a characteristic of the closest product described in the patent upon which examiner relies. Applicant has not received and Examiner's Declaration.

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Applicant's argument is not persuasive for the following reason. The examiner has never indicated that the claimed properties (i.e., tensile strength value, T-H value, and KES bending rigidity value B) are disclosed in the Kawatsu reference. The examiner showed that Kawatsu discloses a heat-sensitive stencil sheet comprises a fibrous support of polyester fibers (which is equivalent to the claimed fiber-containing porous substrate), and a polyester film (which is equivalent to the claimed thermoplastic resin film) laminated on the fibrous support. See abstract, background art and claim 1. It is clear from the above sentence that Kawatsu's compositional and positional limitations are substantially identical to the claimed compositional and positional limitations; therefore, the reference article inherently functions in the same manner claimed by Applicant. It means that the reference article would possess the claimed properties. Therefore, the claimed invention reads upon the disclosed prior art.

Furthermore, the examiner is not capable of performing any scientific tests to show that the reference article inherently functions in the same manner claimed by Applicant. The examiner can only work from the information disclosed in the reference article and the declaration submitted by the applicant. Therefore, the examiner is not capable of providing the applicant a declaration.

In addition, the applicant explains that the declaration of Nakao concerns Sample Nos. 1-9 prepared in a manner described in the present specification.

At this point, it is not clear which Samples or Examples are prepared in a manner described in the prior art, therefore, until the applicant provides a clarification, the

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declaration can not be used as a factual evidence to withdraw the Kawatsu reference as a prior art.

For the above reasons, claims 1 and 4-8 stand rejected and claims 9 and 10 are also included in the rejection.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700



BS *BS*  
November 1, 2002.